

EXPRESS MAIL NO.: EV 331381934 US

Attorney : Derek L. Woods  
Docket No. : 52433/354

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : H. NISHIDA et al.  
Serial No. : 08/295,686  
Filed : August 24, 1994  
For : PROCESS FOR PRODUCTION OF EASY-OPEN CAN LID MADE  
OF RESIN LAMINATED METAL SHEET, EASY-OPEN CAN LID,  
AND RESIN LAMINATED METAL SHEET FOR EASY-OPEN  
CAN LID

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL**

**REQUEST FOR RECONSIDERATION  
OF PETITION UNDER 37 C.F.R. §1.137(a)  
AND  
TRANSMITTAL OF PETITION UNDER 37 C.F.R. §1.181  
TO WITHDRAW HOLDING OF ABANDONMENT**

SIR:

Transmitted herewith in the above-identified patent application is (1) a Request For Reconsideration Of Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application and (2) a Petition Under 37 C.F.R. §1.181 To Withdraw Holding Of Abandonment.

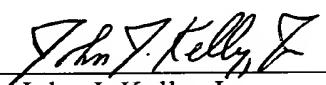
Please charge any required fee due in connection with this Request For Reconsideration Of Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned

Application and any required fee due in connection with this submission of a Petition Under 37 C.F.R. §1.181 To Withdraw Holding Of Abandonment and/or any other required fee due in connection with the submissions and/or this matter to **Deposit Account No. 11-0600**.

A duplicate of this Transmittal letter is enclosed for deposit account charging purposes.

Respectfully submitted,

KENYON & KENYON LLP

By:   
John J. Kelly, Jr.  
Reg. No. 29,182

Dated: November 21, 2008

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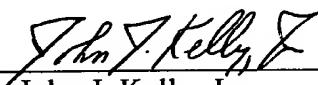
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**REQUEST FOR RECONSIDERATION  
OF PETITION UNDER 37 C.F.R. §1.137(a)  
FOR REVIVAL OF ABANDONED APPLICATION  
AND  
PETITION UNDER 37 C.F.R. §1.181  
TO WITHDRAW HOLDING OF ABANDONMENT**

SIR:

This communication is in response to the DECISION ON PETITION mailed September 22, 2008 in the above-identified patent application dismissing the Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application filed November 9, 1995 (Certificate of Mailing dated November 7, 1995) (hereinafter "Petition").

Reconsideration of the DECISION ON PETITION is respectfully requested.

Applicants hereby renew the Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application filed November 9, 1995.

The Decision On Petition mailed September 22, 2008 was issued after applicant filed Status Request by Certificate of mailing dated August 8, 2008 inquiring as to the status of the Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application filed November 9, 1995 (hereinafter "Status Request").

Applicants submit that the delay between the November 9, 1995 filing date of the Petition and the DECISION ON PETITION mailed September 22, 2008 was due to inaction on the part of the Patent and Trademark Office (hereinafter "Office") acting on the Petition filed November 9, 1995 by the applicants.

#### **Petition Was Actually Received**

The evidence clearly shows that the Petition filed November 9, 1995 by Certificate of Mailing dated November 7, 1995 was actually received by the Office.

#### **Evidence Petition Was Received**

**1. Post Card Receipt**. A true copy of a Post Card Receipt date stamped by the Office on November 9, 1995 acknowledging receipt by the Office of the Petition.

A true copy of this Post Card Receipt is attached after the signature page of the Status Request.

The undersigned attorney hereby verifies that the true copy of Post Card Receipt date stamped by the Office November 9, 1995 is a true copy of the Post Card Receipt maintained in the files of the New York City office of the law firm if Kenyon & Kenyon LLP, that such files are maintained in the ordinary course of business, and it is the ordinary course of business to maintain such files.

**2. Petition Fee Received**. The DECISION ON PETITION acknowledges at page 2, first paragraph, that the fee for a petition to revive an application abandoned unavoidably was received in the Office on November 9, 1995.

**Response Was Actually Received**

The evidence clearly shows that a Response to the Office Action mailed March 24, 1995 along with a Petition Under 37 C.F.R. §1.136(a) for a three (3) month extension of time, both having a Certificate of Mailing dated September 20, 1995, were actually received by the Office on September 22, 1995.

**Evidence Response Was Received**

1. **Post Card Receipt**. A true copy of a Post Card Receipt date stamped by the Office on September 22, 1995 acknowledging receipt by the Office of the Response and Extension Request.

A copy of this Post Card Receipt is provided at Exhibit B of the November 9, 1995 Petition. The November 9, 1995 Petition at page 2, paragraph (B) verifies that this copy of the Post Card Receipt is a true copy.

2. **Extension Fee Received**. The DECISION ON PETITION acknowledges at page 2, first paragraph, that the fee for a three (3) month extension of time was received in the Office on September 22, 1995.

**Verification Of Copy Of Petition**

The undersigned attorney hereby verifies that a true copy of the Petition filed November 9, 1995 attached to the Status Report which includes a copy of a Transmittal letter for the petition, a copy of the Petition, and a copy of Exhibits A to D of the Petition are true copies of such documents maintained in the files of the New York City Office of the law firm of Kenyon & Kenyon LLP, that such files are maintained in the ordinary course of business, and it is the ordinary course of business to maintain such files.

## **GRANTABLE PETITION**

The DECISION ON PETITION stated at page 2 that the showing for a grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:

- (1) A proposed response to continue prosecution of the application;
- (2) The petition fee as set forth in §1.17(1); and
- (3) A showing that the delay was unavoidable.

### **The November 9, 1995 Petition Was Grantable**

It is submitted that the November 9, 1995 Petition was grantable.

**1. Proposed Response**. A copy of the Response to the Office Action mailed March 24, 1995 along with a Petition for a three (3) month extension of time was enclosed as Exhibit A to the November 9, 1995 Petition.

**2. Fee**. The DECISION ON PETITION acknowledges at page 2, first paragraph, that the fee for the petition was to revive an application abandoned unavoidably was received in the Office on November 9, 1995.

**3. Showing**. The Notice of Abandonment of Application No. 08/295,686 was mailed by the Office on October 17, 1995. The Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application was filed by Certificate of Mailing dated November 7, 1995 and was received by the Office on November 9, 1995. Evidence that the November 9, 1995 Petition was actually received by the Office on November 9, 1995 has been previously set forth.

The November 9, 1995 Petition contained in Exhibit A a true copy of the Response to the Office Action mailed March 24, 1995 and a true copy of the Petition for a three month extension of time to respond to the Office Action mailed March 24, 1995, both having a Certificate of Mailing dated September 20, 1995. Evidence that this Response

and Petition for extension of time were actually received by the Office on September 22, 1995 has been previously set forth.

The November 9, 1995 Petition contained in Exhibit B a true copy of the Post Card Receipt for the Response and Petition for extension of time date stamped by the Office on September 22, 1995.

The November 9, 1995 Petition contained in Exhibit C a true copy of Kenyon & Kenyon LLP's outgoing mail log for mail mailed to the Commissioner of Patent & Trademarks on September 20, 1995 and contained in Exhibit D a true copy of Kenyon & Kenyon LLP's Docket Log Book showing a Response in Serial No. 08/295,686 on 9/20. Exhibit C and D evidence that the Response and Petition for extension of time in response to the Office Action mailed March 24, 1995 were processed by the docket department of Kenyon & Kenyon LLP on September 20, 1995, the date of the Certificate of Mailing.

The November 9, 1995 Petition was signed by a person registered to practice before the Patent and Trademark Office (the undersigned attorney). All of the documents of Exhibits A to D of the November 9, 1995 Petition, were verified as true copies of documents maintained in the files of Kenyon & Kenyon LLP.

### **Summary**

It is submitted that the November 9, 1995 Petition was a timely filed and grantable Petition showing that the Notice of Abandonment mailed October 17, 1995 was unavoidable on the part of the applicants and that the Notice of Abandonment mailed October 17, 1995 was an error on the part of the Patent and Trademark Office.

### **Papers and Fees**

All required papers and fees were filed by the applicants.

A Response to the Office Action and Petition for a three(3) month extension of time in response to the Office Action mailed March 24, 1995 were timely filed by the applicants. Evidence that the Response was actually received by Office on September 22, 1995 has been previously set forth. The extension fee was actually received by Office on September 22, 1995.

The November 9, 1995 Petition was diligently and timely filed by the applicants. Evidence that the November 9, 1995 Petition having a Certificate of Mailing dated November 7, 1995 was actually received by the Office on November 9, 1995 has been previously set forth. The petition fee was actually received by the Office on November 9, 1995.

All required papers and fees in this matter were timely filed by the applicants. Adequate evidence of the filing of such papers and payment of such fees has been maintained. It is submitted that delays and errors in this matter are delays and errors on the part of the Office. The usually worthy and reliable employees of the Office did not act upon the papers and fees actually filed by the applicants on September 22, 1995 and November 9, 1995 until the DECISION ON PETITION mailed September 22, 2008.

#### **Process Of Presenting A Grantable Petition**

In the process of presenting a grantable petition, the applicants diligently and timely filed the November 9, 1995 Petition. The next act in the process was on the part of the Office. The evidence shows that the November 9, 1995 Petition was received by the Office. The Office did not act until September 22, 2008 in response to applicants' Status Request filed by Certificate of Mailing dated August 8, 2008.

The applicants have always timely performed acts in this matter in response to actions on the part of the Office. The applicants timely acted in response to the Office

Action mailed March 24, 1995. The Office erroneously issued a Notice of Abandonment. The applicants diligently and timely filed the November 9, 1995 Petition in response to the erroneous Notice of Abandonment. The Office did not act on the applicants November 9, 1995 Petition.

The case law cited in the Analysis portion of the DECISION ON PETITION at page 4 is not applicable to the present matter.

The case of In re Application of Takao, 17 USPQ 2d 1155 (Comm'r Pat. 1990) related to the process of presenting a grantable petition in a timely fashion is not applicable to the present matter.

In Takao at 1156-1157, the facts show that the applicants filed a Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application on October 9, 1996. The Office dismissed the Petition on December 16, 1986. The decision on Petition stated that if reconsidered on the merits is desired an adequate showing of unavoidable delay ...must be submitted *promptly*. On March 18, 1988, the applicants submitted a Renewed Petition, i.e., 14 months after the Office decision advising the applicants to make a submission *promptly*.

In Takao the applicants did not act promptly in response to a decision of the Office which expressly advised the applicants to act *promptly* if reconsideration was desired in response to the decision of the Office.

The present matter is completely different than Takao. In the present matter, the Office did not act in response to the applicants' November 9, 1995 Petition.

In Winkler v. Ladd, 221 F. Supp 550 (D.D.C. 1962), the facts of this case at 552 are that the assignee for the benefit of creditors had abandoned the application.

Winkler is not a case where the Office did not act in response to a paper filed in the Office by the applicant, e.g., the November 9, 1995 Petition.

In Future Technology, Ltd. v. Quigg, 684 F. Supp. 430, the facts of this case are that the Office issued a rejection of the application on June 18, 1984. The applicant did not respond to the rejection of the Office and the Office issued a Notice of Abandonment.

In Future Technology, the applicant did not act in response to an action of the Office. Future Technology is not a case where the Office did not act in response to a paper filed in the Office by the applicant, e.g., the November 9, 1995 Petition.

The present matter is also completely different than Winkler or Future Technology. In the present matter, the Office did not act in response to the applicants' November 9, 1995 Petition.

No case has been cited by the DECISION ON PETITION to support the decision to dismiss the November 9, 1995 Petition.

No case has been cited in the DECISION ON PETITION where the Office did not act on a paper timely filed by the applicant and wherein the evidence shows that this paper filed by the applicant was actually received by the Office

### **CONCLUSION**

The applicants in this matter have acted in a timely manner in response to all actions of the Office. The Office did not act until September 22, 2008 in response to the November 9, 1995 Petition of the applicants which the evidence shows was actually received by the Office. The delays and errors in this matter are on the part of the Office.

### **RELIEF REQUESTED**

It is therefore respectfully requested that:

- (1) reconsideration be given to the DECISION ON PETITION;
- (2) this paper be considered a renewal of the November 9, 1995 Petition;

Petition;

- (3) the dismissal of the November 9, 1995 Petition be withdrawn;
- (4) the November 9, 1995 Petition be granted;
- (5) the Notice of Abandonment of the above-identified patent application mailed October 17, 1995 be withdrawn; and
- (6) the above-identified patent application be revived and returned to prosecution on the merits.

**Petition Under 37 C.F.R. §1.181  
To Withdraw Holding of Abandonment**

Applicants respectfully petition under 37 C.F.R. §1.181 to withdraw the holding of abandonment of the above-identified patent application by the Notice of Abandonment mailed October 17, 1995. This petition under 37 C.F.R. §1.181 is being filed in response to the DECISION ON PETITION mailed September 22, 2008 which was the first action by the Office advising that applicants November 9, 1995 Petition under 37 C.F.R. §1.137(a) for revival of the above-identified patent application was dismissed.

The facts and documentation supporting this petition under 37 C.F.R. §1.181 to withdraw the holding of abandonment of the above-identified patent application have been hereinbefore set forth in detail and are incorporated herein by reference.

A true copy of the Response to the Office Action mailed March 24, 1995, along with a Petition for a three (3) month extension of time, which the evidence shows were actually received by the Office on September 22, 1995, appear in Exhibit A of the Petition Under 37 C.F.R. §1.137(a) For Revival Of Abandoned Application, a true copy of which was enclosed with the Status Request filed by Certificate of Mailing dated August 8, 2008 and is hereby incorporated by reference.

**RELIEF REQUESTED**

It is respectfully requested that:

(1) this Petition Under 37 C.F.R. §1.181 to withdraw the holding of abandonment of the above-identified patent application be granted;

(2) the holding of abandonment of the Notice of Abandonment mailed October 17, 1995 be withdrawn; and

(3) the above-identified patent application be revived and returned to prosecution on the merits.

Respectfully submitted,

KENYON & KENYON LLP

By: John J. Kelly, Jr.  
John J. Kelly, Jr.  
Reg. No. 29,182

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